

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
David R. Mikalonis et al.)	Group Art Unit: 3656
Application No.: 10/583,350)	Examiner: James Pilkington
Filed: June 19, 2006)	Confirmation No.: 2596
For: ROLLING BEARING HAVING A)	
NICKEL-PHOSPHORUS COATING)	

ELECTION AND RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In an Official Action dated October 20, 2009, the Examiner has indicated that restriction to one of the following inventions is required under 35 U.S.C. §121:

Group I: Claims 1-9, 16 and 17, drawn to a rolling bearing apparatus; and

Group II: Claims 10-15, drawn to a method of making a rolling bearing.

Accordingly, applicants provisionally elect Group I, the subject matter of Claims 1-9, 16 and 17, with traverse.

Applicants submit that the restriction requirement is in error. It is believed that in examining the non-elected claims, the Examiner's search of the invention of the elected claims will overlap the search of the non-elected claims to such an extent that examination of all claims together in a single application will not pose a serious burden.

Thus, this restriction will not reduce the workload of the U.S. Patent and Trademark Office or simplify prosecution of the application. As set forth in M.P.E.P. §803, there are two criteria for a proper restriction requirement between patentably

distinct inventions: (1) the inventions must be independent or distinct as claimed; and
(2) there must be a **serious burden** on the Examiner if restriction is not required.

This portion of the M.P.E.P. requires that if the search and examination of an entire application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions.

Accordingly, reconsideration and withdrawal of the aforementioned restriction requirement is respectfully requested. The provisional election is hereby made without prejudice to Applicants' right to file a divisional application or applications should the restriction requirement become final.

Respectfully submitted,

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Date: November 20, 2009

By:



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